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10/813,557	03/31/2004	Joseph E. Paganessi	Serie 6390	4106

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EXAMINER
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MERKLING, MATTHEW J

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOSEPH E. PAGANESSI and FREDERICK W. GIACOBBE

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Appeal 2009-011389  
Application 10/813,557  
Technology Center 1700

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Before BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

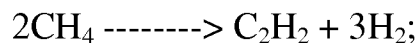
Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision<sup>2</sup> finally rejecting claims 10, 12, and 15-18, the only claims pending in the Application. (Br.<sup>3</sup> 3.) We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates to “generating acetylene for direct on-site use in a process such as carburization.” (Spec.<sup>4</sup> 1:10-11.) Claim 10, the sole independent claim on appeal, is reproduced below from the Claims Appendix to the Appeal Brief:

10. A method of generating and supplying acetylene, comprising:

generating acetylene in an acetylene generation device by directing at least one reactant feed stream including methane into the acetylene generation device, wherein the acetylene generation device comprises an arc plasma reactor including an anode and a cathode disposed within the reactor, and the acetylene is generated by generating plasma within the reactor via a power supply connected to the anode and the cathode thereby yielding acetylene and hydrogen according to the formula:



directing the generated acetylene to an acetylene processing device disposed in-line and downstream from the acetylene generation device; and

operating the acetylene processing device to consume at least a portion of the acetylene.

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<sup>2</sup> (Final Office Action (“Final”), mailed Apr. 17, 2008.)

<sup>3</sup> (Appeal Brief, filed Nov. 17, 2008.)

<sup>4</sup> (Specification, filed Mar. 31, 2004.)

The Examiner maintains (Ans.<sup>5</sup> 3-6), and Appellants request review of (Br. 6), the following grounds of rejection:

1. claims 10 and 12 under 35 U.S.C. § 103 as unpatentable over Colton (US 3,256,358, issued Jun. 14, 1966) in view of Kubota (US 5,702,540, issued Dec. 30, 1997); and

2. claims 15-18 under 35 U.S.C. § 103 as unpatentable over Colton and Kubota as applied to claim 10, and further in view of Hook (US 5,960,634, issued Oct. 5, 1999) as evidenced by Poor (US 7,033,446 B2, issued Apr. 25, 2006).

Appellants rely on the same arguments in traversing both grounds of rejection. Appellants' arguments are directed to limitations found in independent claim 10. The sole issue presented for our review is: did the Examiner fail to establish a prima facie case of obviousness as to claims 10, 12, and 15-18 because the Examiner did not properly explain the motivation for combining the methods of Colton and Kubota to form an in-line processing method?

Appellants do not dispute the Examiner's finding that Colton discloses a step of generating acetylene in an acetylene generating device as claimed in the first step of claim 10. (*Cf.* Br. 8.) Nor do Appellants dispute the Examiner's finding that Kubota discloses an acetylene processing device which is capable of consuming acetylene generated from Colton's acetylene generating device. (*See* Br. 8, last para.) Rather, Appellants argue the Examiner failed to properly explain the motivation for combining the Colton and Kubota methods in the manner claimed. According to Appellants, "the Examiner has merely provided the conclusory statement that it is obvious to

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<sup>5</sup> (Examiner's Answer, mailed Feb. 20, 2009.)

combine a generation process with an end use of a material generated in a process.” (Br. 10.)

The Examiner, in response, explains that “one of ordinary skill in the art at the time of the invention would . . . find motivation to place the acetylene generation device and the acetylene processing device in a single system in order to eliminate the additional costs of transportation of the acetylene from one site to another.” (Ans. 7, ll. 2-5.) The Examiner also states that it would have been within the level of skill of the ordinary artisan to have connected Colton’s and Kubota’s devices at the same site via a pipeline. (Ans. 8.)

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology-independent and the combination of references results in a product or process that is more desirable for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

*Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

Appellants have not addressed the above-quoted/cited explanation by the Examiner regarding motivation to combine Colton and Kubota, which

explanation we find to be reasonable.<sup>6</sup> Nor have Appellants argued that the ordinary artisan would not have possessed the knowledge and skills necessary to combine the Colton and Kubota methods in the manner claimed. (*See generally*, Br.) Absent such arguments, we are not convinced of error in the Examiner's obviousness determination. Accordingly, we sustain both grounds of rejection.

The Examiner's decision to reject claims 10, 12, and 15-18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

kmm

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<sup>6</sup> We note that Appellants have elected not to file a Reply Brief to the Examiner's Answer, *see* 37 C.F.R. § 41.41.